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10/595,846

05/16/2006

Heino Weigand

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12/24/2008

REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

599 LEXINGTON AVENUE, 29TH FLOOR

NEW YORK, NY 10022-7650

EXAMINER

JONES, JAMES

ART UNIT

PAPER NUMBER

2873

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---------------------------------------|--|
| Office Action Summary | Application No. 10/595,846 | Applicant(s) WEIGAND ET AL. | |
| | Examiner JAMES C. JONES | Art Unit 2873 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14 and 16-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14 and 16-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harino et al (6238385) hereafter Harino in view of Smith et al. (20060200013) hereafter Smith.

Regarding claim 11 Harino discloses a method of orienting the eye of a patient to help prevent the eye from moving in a manner that would interfere with treatment being carried out by an for ophthalmologic treatment devices (fig. 8, col. 1, lines 45-60, col. 4, lines 15-30, col. 6, lines 45-58), the method comprising the steps of: projecting the a fixation mark to be displayed in the field of vision of the eye to be treated (fig. 8); allowing the patient to orient the eye to be treated on this fixation mark through foveal fixation (fig. 8, col. 1, lines 45-60, col. 4, lines 15-30, col. 6, lines 45-58); and moving the fixation mark in the field of vision of the patient, wherein the movement of the fixation mark is used to position the eye in a specific manner so that (a) the patient can easily follow the fixation mark and (b) the eye is less likely to move in a manner that would interfere with the treatment being carried out by the ophthalmologic treatment device (fig. 8, col. 1, lines 45-60, col. 4, lines 15-30, col. 6, lines 45-58) but does not specifically disclose the movement of the fixation mark making the eye less likely to move during

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the treatment being carried out by the ophthalmologic treatment device. Smith teaches that in ophthalmic devices that it is desirable to for the movement of the fixation mark to make the eye less likely to move during the treatment being carried out by the ophthalmologic treatment device (par. [0118], lines 8-12) for the purpose of allowing accurate optical treatment. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the fixation mark of Harino moveable for making the eye less likely to move during the treatment being carried out by the ophthalmologic treatment device as modified by Smith since Smith teaches that in ophthalmic devices that it is desirable to for the movement of the fixation mark to make the eye less likely to move during the treatment being carried out by the ophthalmologic treatment device for the purpose of allowing accurate optical treatment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sponsel et al. (2004/0046934) hereafter Sponsel in view of Harino et al (6238385) hereafter Harino and further in view of Smith et al. (20060200013) hereafter Smith.

Regarding claim 11-14 and 16 Sponsel discloses a method for displaying a fixation mark for ophthalmologic treatment devices (par. [0033]) comprising the steps of:

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projecting the fixation mark to be displayed in the field of vision of the eye to be treated (fig. 3-7, par. [0047]); moving the fixation mark in the field of vision of the patient, wherein the movement is carried out in such a way that the patient can easily follow the fixation mark; movement of the fixation mark in the field of vision of the patient is carried out continuously or discontinuously, according to a predetermined sequence, or randomly (par. [0047], lines 9-15); the fixation mark is moved discontinuously in the field of vision of the patient, diagnosis or therapy being carried out only within short stationary phases of the fixation mark; the fixation mark is moved in the field of vision of the patient and a measurement or therapy is carried out while the eye follows the movement of the fixation mark; the movement of the fixation mark is used to position the eye in a specific manner; and the movement of the fixation mark is carried out through variable projection on a stationary display (fig. 3-7, par. [0047]- [0048]) but does not specifically disclose the ophthalmic device allowing the patient to orient the eye to be treated on the fixation mark through foveal fixation. '385 teaches that in an ophthalmic device it is desirable to allow the patient to orient the eye to be treated on the fixation mark through the foveal fixation (fig. 8, col. 1, lines 45-60, col. 4, lines 15-30, col. 6, lines 45-58) for the purpose of reducing undesired movements of the eye. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the method of allowing the patient to orient the eye to be treated on the fixation mark through the foveal fixation in the ophthalmic device of '934 as modified by '385 since '385 teaches that in an ophthalmic device it is desirable to allow the patient to orient the eye to be treated on the fixation mark through the foveal fixation for

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the purpose of reducing undesired movements of the eye. The combination of Sponsel and Harino disclose and teach as set forth above but does not specifically disclose the movement of the fixation mark making the eye less likely to move during the treatment being carried out by the ophthalmologic treatment device. Smith further teaches that in ophthalmic devices that it is desirable to for the movement of the fixation mark to make the eye less likely to move during the treatment being carried out by the ophthalmologic treatment device (par. [0118], lines 8-12) for the purpose of allowing accurate optical treatment. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to have the fixation mark in the combination of Sponsel as modified Harino moveable for making the eye less likely to move during the treatment being carried out by the ophthalmologic treatment device as further modified by Smith since Smith teaches that in ophthalmic devices that it is desirable to for the movement of the fixation mark to make the eye less likely to move during the treatment being carried out by the ophthalmologic treatment device for the purpose of allowing accurate optical treatment.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sponsel et al. (2004/0046934) hereafter Sponsel in view of Harino et al (6238385) hereafter Harino, further in view of Smith et al. (20060200013) hereafter Smith and further in view of Jernigan (3984156) hereafter Jernigan.

Regarding claims 17-20 Sponsel ('934), Harino ('385), and Smith ('013) disclose as set forth above but does not specifically disclose the movement of the fixation mark is carried out by an XY mirror unit; a movement of the fixation mark in the field of vision

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of the patient of a diagnostic beam or therapeutic beam is carried out by a XY mirror unit; a movement of a diagnostic beam or therapeutic beam is corrected by a predetermined movement of the fixation mark; and a movement of a diagnostic beam or therapeutic beam is corrected by the movement of the fixation mark which is acquired online. '156 further teaches that in an ophthalmic device it is further desirable to have the movement of the fixation mark carried out by an XY mirror unit; the movement of the fixation mark and of a diagnostic beam or therapeutic beam carried out by the same XY mirror unit; the movement of a diagnostic beam or therapeutic beam corrected by the predetermined movement of the fixation mark; and the movement of a diagnostic beam or therapeutic beam corrected by the movement of the fixation mark which is acquired online (fig. 1, col. 15, ln. 42-68 and col. 16, ln. 1-17) for the purpose of monitoring the movements of the eyes and responses of the target positions during measuring and evaluating a patient's visual field (abstract, ln. 1-8 of '156). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the method of the movement of the fixation mark carried out by an XY mirror unit; the movement of the fixation mark and of a diagnostic beam or therapeutic beam is carried out by the same XY mirror unit; the movement of a diagnostic beam or therapeutic beam is corrected by the predetermined movement of the fixation mark; and the movement of a diagnostic beam or therapeutic beam is corrected by the movement of the fixation mark which is acquired online in the ophthalmic device of Sponsel as modified by Harino, further modified by Smith, and even further modified by Jernigan since Jernigan further teaches that in an ophthalmic device it is further desirable to have

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the movement of the fixation mark carried out by an XY mirror unit; the movement of the fixation mark an of a diagnostic beam or therapeutic beam carried out by the same XY mirror unit; the movement of a diagnostic beam or therapeutic beam corrected by the predetermined movement of the fixation mark; and the movement of a diagnostic beam or therapeutic beam corrected by the movement of the fixation mark which is acquired online for the purpose of monitoring the movements of the eyes and responses of the target positions during measuring and evaluating a patient's visual field.

Response to Arguments

Applicant's arguments with respect to claims 11-14 and 16-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

2. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES C. JONES whose telephone number is (571)270-1278. The examiner can normally be reached on Monday thru Friday, 8 a.m. to 5 p.m. est. time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James C. Jones/
Examiner, Art Unit 2873
12/14/2008

/Ricky L. Mack/
Supervisory Patent Examiner, Art Unit 2873